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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/853,170 | 05/10/2001 | Yuhichi Nakamura | JP920000106US1 | 5940 |

7590 05/19/2006

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EXAMINER

KESACK, DANIEL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3624

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/853,170 | | NAKAMURA ET AL. | |
| | Examiner | | Art Unit | |
| | Dan Kesack | | 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/10/01; 8/31/01</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS Mail Date 6/4/04</u> . |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-19 are currently pending.
The rejections are as stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites "view request accepting means for accepting a view request from said user terminal." Particularly, it is unclear what is being requested to be viewed, and therefore the scope of the claim is unascertainable, rendering the claim indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6, 12, 16, 17, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Makipaa, U.S. Patent No. 6,394,341.

Claims 1, 12, 16, 17, 19, Makipaa discloses a system and method for collecting financial transaction data, comprising a user terminal connected to a network (column 3 lines 4-28), a service provider connected to said network for providing the user terminal with household account information (column 7 lines 17-54), wherein said service provider adds additional information and provides the information to said user terminal, wherein the information is based on the analysis results regarding household account information (column 6 line 47 – column 7 line 6, column 11 line 60 – column 12 line 16).

Claim 2, Makipaa teaches an information processing module for analyzing household account information and providing addition information based on analysis results (column 6 line 47 – column 7 line 6, column 11 line 60 – column 12 line 16).

Claim 3, Makipaa teaches the module being connected to a service provider over a network, and inherently teaches that the module which analyzes and processes the information is provided by an information processing company.

Claim 4, Makipaa teaches the service provider having the contents of items updated on the basis of a change of contents in bank account information (column 17 lines 22-40).

Claim 6, Makipaa discloses a system and method for collecting financial transaction data, comprising a user terminal connected to a network (column 3 lines 4-28), an account information updating feature for updating information in response to an update of bank account information (column 1 line 50 – column 2 line 12), an information adding feature for adding information in response to additional marketing information (column 11 line 60 – column 12 line 16), and a notification feature for notifying the user terminal of account information updates (column 13 lines 27-35).

6. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Chancey, U.S. Patent No. 5,842,185.

Claim 11, Chancey discloses a system and method for tracking financial transactions, comprising acquiring means for acquiring account information (figure 1, #4, #6, #10), analyzing means for analyzing said acquired account information and determining means for determining additional information to be added to the account

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information on the basis of results by said analyzing means (column 4 line 64 – column 5 line 12), and output means for outputting the information (figure 1, #4 and #16, figure 2).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makipaa, as applied to claim 1 above, and further in view of Goldsmith, U.S. Patent No. 6,064,990.

Claim 4, Makipaa fails to teach the household account information has its contents updated on the basis of a change of contents in bank account information.

Schrader teaches the service provider having the contents of items updated on the basis of a change of contents in bank account information (column 17 lines 22-40). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Makipaa to include the updating on the basis of a change of bank account information because it is desirable that account data is always current and updated.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makipaa, as applied to claim 1 above, and further in view of Chancey, U.S. Patent No. 5,842,185 and Blonder, U.S. Patent No. 5,708,422.

Claim 5, Makipaa teaches assigning categories to transactions based on transaction information, and producing detailed records by transaction category. Makipaa fails to teach categories including income and expenditure items.

Chancey also teaches assigning a category to a transaction based on the transaction information. Chancey teaches these categories including income and purchases (column 3 lines 32-40). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the category groupings of Makipaa to include income and expenditure items because these are two common types of transactions, and it is desirable to view transactions by these categories.

Claim 5, Makipaa also fails to teach sending a predetermined notice to a user on the basis of a set notification condition.

Blonder teaches a transaction authorization and alert system wherein a user sets alert conditions (figure 3), pertaining to financial transactions, for which the user should be notified, and notifying the user if a transaction matches said conditions. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Makipaa to include a conditional transaction alert system because of the benefits of alerting an account holder of account changes, as described by Blonder (column 2, lines 30-50).

11. Claims 7, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makipaa, as applied to claim 6 and 12 above, and further in view of Lawlor, U.S. Patent No. 5,870,724.

Claims 7, 8, 15, Makipaa teaches analyzing a user's transaction history to produce marketing information describing a user's buying habits (column 11). Makipaa fails to teach delivering advertisements to the user based on the transaction history analysis.

Lawlor teaches maintaining a database of transactions, and extracting demographic information for use in targeting advertisements electronically, directly the terminal of a home-banking user (column 13 lines 58-64). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Makipaa to include delivering advertisement information to the user

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because the transaction history analysis provides valuable information, allowing the advertisers save resources by directing their marketing towards a specific target demographic. As describe in both Makipaa and Lawlor, the sale of this information is also a desirable revenue stream for the operators of the Makipaa and Lawlor inventions.

12. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor, U.S. Patent No. 5,870,724 in view of Blonder, U.S. Patent No. 5,708,422.

Claims 9, 10, Lawlor teaches a view request accepting means for accepting a view request (figure 3 #108), account information providing means for providing the account information to the user terminal (figures 3, 21A-C). Lawlor also teaches sending electronic messages to the user terminal. Lawlor teaches the messages optional being advertisements delivered to the user based on analysis of information extracted from transaction information (column 13 lines 58-64). Lawlor fails to teach notification conditions accepting means, and providing the account information to the terminal if it matches the notification conditions.

Blonder teaches accepting notification conditions, and delivering messages to a user if a transaction taking place matches the notification conditions. It would It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Lawlor to include a conditional transaction alert system which sends messages to the user based on alert conditions because of the benefits of alerting an account holder of specific account changes, as described by Blonder (column 2, lines 30-50).

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makipaa, as applied to claim 12 above, and further in view of Chancey, U.S. Patent No. 5,842,185.

Claim 13, Makipaa teaches assigning categories to transactions based on transaction information, and producing detailed records by transaction category. Makipaa fails to teach categories including income and expenditure items.

Chancey also teaches assigning a category to a transaction based on the transaction information. Chancey teaches these categories including income and purchases (column 3 lines 32-40). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the category groupings of Makipaa to include income and expenditure items because these are two common types of transactions, and it is desirable to view transactions by these categories.

14. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makipaa, as applied to claim 12 above, and further in view of Blonder, U.S. Patent No. 5,708,422.

Claims 14, 18, Makipaa fails to teach sending a predetermined notice to a user on the basis of a set notification condition.

Blonder teaches a transaction authorization and alert system wherein a user sets alert conditions (figure 3), pertaining to financial transactions, for which the user should be notified, and notifying the user if a transaction matches said conditions. It would

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have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Makipaa to include a conditional transaction alert system because of the benefits of alerting an account holder of account changes, as described by Blonder (column 2, lines 30-50).

Conclusion

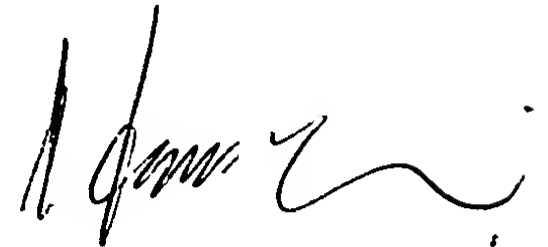
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schrader et al., U.S. Patent No. 5,903,881 discloses a personal online banking with integrated online statement and checkbook user interface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hani M. Kazimi', with a stylized flourish at the end.

HANI M. KAZIMI
PRIMARY EXAMINER